

REMARKS

The above-referenced application was filed on March 1, 2002. The application as filed included thirty claims. Claims 5, 11-26, and 28-30 have been withdrawn from consideration.

In the outstanding Office action, claims 1, 4, 6-8, 10, and 27 are rejected as anticipated under 35 U.S.C. § 102(b). In addition, claims 2, 3, and 9 are rejected as obvious under 35 U.S.C. § 103(a). Accordingly, claims 1-30 remain pending, with claims 1-4, 6-10, and 27 being at issue. Reconsideration and allowance of all claims are requested.

I. The 35 U.S.C. § 102 (b) Rejections Are Improper

The Examiner rejected claims 1, 4, 6-8, 10, and 27 under 35 U.S.C. § 102(b) as being anticipated by Perrin, U.S. Patent No. 4,474,318 (hereinafter "'318"). Applicant respectfully submits that the '318 reference fails to disclose each and every element of claims 1, 4, 6-8, 10, and 27 and, therefore, fails to anticipate these claims¹.

Independent claims 1, 8, and 27, and those claims dependent thereon, specify, *inter alia*, a dispenser comprising a cutter bar having a plurality of teeth separated by a plurality of valleys, each valley being spaced away from the trunk, lid, or tear line by a predetermined registration zone.

The '318 reference fails to disclose each and every such element and, thus, fails to anticipate the claims. The '318 patent is primarily directed to a mechanism for holding the film so as to prevent it from retracting into the carton after severing. With respect to its cutter bar, the '318 disclosure is limited. The '318 patent only discloses a "cutter bar 28, preferably a saw-toothed metal or plastic strip, ... connected by clinching, adhesion, rivets or the like to the bottom wall 16 and located at the outside juncture of the lower edge of the front wall 18 and the bottom wall 16 to permit easy severance of a sheet 26 of film after a desired length has been withdrawn from the carton 10." See col. 3, ll. 55-61. As shown best in Figs. 7 and 8, the cutter bar of '318 (28) includes a base and a saw-toothed edge extending out from the

¹ "Anticipation under 35 U.S.C. § 102 requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention." *Rockwell Int'l Corp. v. United States*, 47 U.S.P.Q. 2d 1027 (Fed. Cir. 1998).

bottom wall 16 of the carton. However, the positioning of the valleys of the cutter bar relative to the dispensing carton is not discussed in the specification at all.

In this regard, the Examiner asserts that the '318 reference teaches a cutter bar spaced away from the bottom wall of the container by a predetermined registration zone, specifically citing to col. 3, ll. 31-68 and col. 4, ll. 1-61 of the '318 reference for this proposition. *See* Office action, page 2. However, as indicated above, nowhere in the text of the '318 reference does the patentee address the cutter bar as being spaced away from the trunk, lid, or tear line by a predetermined registration zone, as required by claims 1, 8, and 27. Even the drawings fail to disclose such spacing. In fact, if anything, the drawings disclose the valleys of the cutter bar even with a corner edge 17 between panels 16 and 18. *See* figs. 1, 2, and 6-8. Moreover, even if the Examiner can deduce some spacing between the cutter bar valleys and the carton edge, such spacing would certainly not be "predetermined" or be a "registration zone," as such limitations would require recognition of the desirability of such features and discussion of the same in the specification. Here, none is provided.

In addition to the above, independent claims 8 and 27 further specify, *inter alia*, a cutter bar attached to a reinforcing member or means for reinforcing proximate the cutter bar, respectively.

The '318 reference fails to disclose such elements and, thus, fails to anticipate claims 8 and 27 for this reason as well. The '318 patent discloses a cutter bar 28 mounted to a bottom panel 16. No reinforcing member is provided therebetween. In fact the only mention of "reinforcing" in the '318 patent is with respect to panel 40, but panel 40 is provided to reinforce retaining edge 46. This is not surprising in that again the focus of the '318 patent is the edge 46, not the cutter bar.

In light of the above-described distinctions, Applicant respectfully submits that independent claims 1, 8, and 27, as well as those claims dependent thereon, cannot be anticipated by the '318 reference and, therefore, the rejection should be withdrawn.

II. The 35 U.S.C. § 103 (a) Rejections Are Improper

The Examiner rejected the remaining claims at issue, *i.e.*, claims 2, 3, and 9, under 35 U.S.C. § 103(a) as unpatentable over '318. Reconsideration and withdrawal of this rejection is requested in view of the following remarks.

Claims 2 and 3 are dependent on claim 1. Claim 2 further specifies a registration zone within the range of about 0.01 to 0.05 inches, while claim 3 further specifies a registration zone having a width of approximately 0.03125 inches. Claim 9 is dependent on claim 8 and further specifies a registration zone having a width dimension of at least 0.03125 inches. Each claim is dependent on the above-distinguished independent claims, and, therefore, the rejection of such claims as obvious over the same anticipatory art is misplaced.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings of a plurality of references. Finally, there must be a reasonable expectation of success. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's own disclosure. *See In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). *See also* MPEP § 2143.

The examiner bears the burden of establishing a *prima facie* case of obviousness and "can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). To support a conclusion that a claimed combination is obvious, either: (a) the references must expressly or impliedly suggest the claimed combination to one of ordinary skill in the art, or (b) the examiner must present a convincing line of reasoning as to why a person of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *See In re Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Int. 1985). If the teachings of various references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art,

considering the degree to which one reference might accurately discredit another. *See In re Young*, 18 U.S.P.Q.2d 1089 (Fed. Cir. 1991).

As indicated above, with respect to cutter bars, the '318 patent only discloses a "cutter bar 28, preferably a saw-toothed metal or plastic strip, ... connected by clinching, adhesion, rivets or the like to the bottom wall 16 and located at the outside juncture of the lower edge of the front wall 18 and the bottom wall 16 to permit easy severance of a sheet 26 of film after a desired length has been withdrawn from the carton 10." *See* col. 3, ll. 55-61.

The Examiner asserts that "[t]he width of the registration zone in Fig. 6 in ['318] appears to be the same as the width of the registration zone in Fig. 2 of the Applicant's drawings." *See* Office action, page 4. However, such observations are irrelevant. As discussed above, the Examiner is improperly attributing characteristics to the device of the '318 reference that are not apparent from the drawings. Specifically, in neither the present application nor in the '318 reference is the positioning of the cutter bar apparent from viewing the drawings. Further, nowhere in the '318 specification is a cutter bar positioned at any predetermined registration zone discussed, much less a registration zone of any specified width. Again, it is clear that such a construction was not contemplated by the '318 patentee, as neither the '318 specification nor the drawings disclose or discuss any advantages thereof. Indeed, the '318 reference discloses an improvement on dispensing cartons that is completely unrelated to the cutter bar or the positioning thereof.

The '318 reference does not disclose or suggest a registration zone of between 0.01 to 0.05 inches, or of 0.03125 inches. As a result, at least the first criteria of MPEP § 2143 is not met and, thus, '318 cannot render the claims obvious.

Moreover the second requirement under MPEP § 2143 is not met. The second requirement necessitates that a suggestion be provided to modify the cited art to arrive at the claimed subject matter. The '318 patent provides no such suggestion. It merely discloses a cutter bar generally, without any mention of the benefits to be achieved by a positioning the cutter bar at a specific location. Without such mention, it clearly cannot suggest the exact modification of a predetermined registration zone, much less the exact dimension of the registration zone specified in the claims.

In light of the foregoing, a *prima facie* case of obviousness has not been established and the associated rejection should, therefore, be withdrawn.

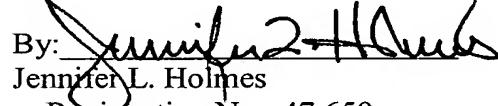
CONCLUSION

For the foregoing reasons, reconsideration and withdrawal of the rejections, and allowance of all pending claims are requested.

Should the Examiner wish to discuss the foregoing, or any matter of form or substance in an effort to advance this application to allowance, he is respectfully invited to contact the undersigned attorney.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP
233 S. Wacker Drive
6300 Sears Tower
Chicago, Illinois 60606-6357
(312) 474-6300

By: 
Jennifer L. Holmes
Registration No.: 47,659
Attorney for Applicant

Dated: October 24, 2003